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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,476	11/28/2003	Hisaya Suzuki	245671US90	9964
22850	7590	06/07/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			JUBA JR, JOHN	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/722,476

Applicant(s)

SUZUKI ET AL.

Examiner

John Juba, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 12-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,10 and 11 is/are rejected.
- 7) ☒ Claim(s) 5-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/28/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/03, 9/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Election/Restrictions***

Applicant's election with traverse of Group V in the reply filed on March 11, 2005 is acknowledged. The traversal is on the ground(s) that Applicant views the searches as being coextensive, and that as such there appears to be no serious burden. This is not found persuasive because the manual search involves consideration of thousands of documents as they relate to the *single* elected invention. Consideration of multiple inventions (combinations and subcombinations), even if the examiner could have the myriad features (combinations and subcombinations) in mind, would slow the search to such an extent that the available time would be exhausted before an Office action could be prepared. Clearly, the inability to complete an Office action in the time allowed represents a serious burden. Thus, Applicant's supposition is contrary to fact, and the argument is moot.

The identified MPEP passage refers not only to search, but also to *examination* of each invention. Examination involves evaluation of each original claim as to scope and clarity, explication as to the anticipation or obviousness of each claim limitation, reevaluation of the prior art in light of Applicant's rebuttal or amendment. Since entry of additional claims to the same invention is a matter of right in response to the non-final Office action, examination of more than a single invention also presents a serious burden. The search process may need to be repeated or extended as to limitations to the single invention not previously presented, and the aforementioned examination functions must be repeated.

Accordingly, it should be apparent that search *and examination* of more than one invention poses an serious burden. The requirement is still deemed proper and is therefore made FINAL.

The requirement is still deemed proper and is therefore made FINAL.

Claims 2 and 12 – 37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 11, 2005.

Claim 1 link(s) inventions I, V, VI, VII and VIII. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### ***Drawings***

The drawings are objected to because of the following informalities:

In Figures 1, 2, 6, 14, 17, and 23, "window" is misspelled for lead line W.

In Figure 25, "mirror" is misspelled for lead line (130).

Figure 33 should be designated by a legend such as --Prior Art-- because only that which is old ("conventional") is illustrated. See MPEP § 608.02(g).

The examiner apologizes for the delay in identifying these deficiencies. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The title of invention is not description. The examiner suggests something along the lines of:

“Retractable exterior vehicle mirror with downward viewing, perimeter lighting, and mirror alignment features”.

The specification is objected to for the following informalities. Appropriate correction is required:

On Page 24, there are typographical errors in the section heading at line 17.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

Claims 1 and 3 – 11 are objected to for the following informalities. Appropriate correction is required.

In the eighth line of claim 1, “wherein;” should read “wherein”, or other punctuation should be added. Claims 3 – 11 are objected to as inheriting the same informality through their dependency from claim 1.

In the first line of each of claims 3 – 11, “wherein;” should read “wherein”, or other punctuation should be added.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tadashi (JP 08-238984 A), in view of Sugimoto (JP 60-128838 U). Referring *for example* to Figure 1 and the attached machine translation, Tadashi discloses a mirror base (6) being attached on a side [door] surface of an automobile body and extending sideward from said surface of said automobile body, and a mirror housing (1) having a separation distance from said side of said automobile body, suspended underneath said mirror base with a rotation capability to be reset into a housing position, wherein a first auxiliary "mirror" (4) facing obliquely downward is attached to said mirror housing so as to face said side of said automobile. Thus, Tadashi discloses the invention substantially as claimed. However, Tadashi discloses the first auxiliary mirror as mounted *in* the housing and does not disclose the mirror housing as having a side surface facing the side of the automobile, and thus does not disclose the first auxiliary mirror attached to such a housing side surface.

In the same field of endeavor, Sugimoto discloses (Fig. 2) a mirror base attached to an automobile side surface and supporting a mirror housing, the mirror housing having a side surface facing the side of the automobile and supporting a first auxiliary

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mirror. Sugimoto fairly teaches the utility of providing the driver with a main adjustable mirror, and a separate auxiliary mirror having its own adjustment means.

It would have been obvious to one of ordinary skill to provide the auxiliary "mirror" of Tadashi as a separately adjustable mirror element mounted on a side surface of the mirror housing, in the interest of providing the driver with an adjustable main mirror element and a separately adjustable auxiliary mirror element, as suggested by Sugimoto. One of ordinary skill would have appreciated that the provision of separate adjustability of the mirror elements would have permitted use of the viewing arrangement by drivers of various statures and seated postures, and would have offered greater flexibility as to the regions viewed by the drivers.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tadashi, in view of Sugimoto, and further in view of KANTO AUTO WORKS (JP 08-058473 A). As set forth above for claim 1, Tadashi and Sugimoto suggest the invention substantially as claimed. However, these references do not disclose a second auxiliary mirror facing obliquely downward and attached to the mirror base on a side facing rearward of the automobile, as recited.

In the same field of endeavor, KANTO AUTO WORKS disclose an outer mirror comprising a mirror base (10) attached to a side surface of an automobile and a mirror housing with a rotation capability to be reset into a housing position. KANTO AUTO WORKS teach that it is useful to provide an auxiliary mirror (16) facing obliquely downwardly (e.g., to view a rear tire; see para. [0010]) attached to the mirror base on a



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side facing rearwardly of the automobile body. KANTO AUTO WORKS teach that such a provision affords the driver a useful field of view to the rear of the automobile, even when the main mirror is folded into a storage position.

It would have been obvious to one of ordinary skill to provide a second auxiliary mirror facing obliquely downwardly and attached to the mirror base of Tadashi and Sugimoto on a side facing rearwardly of the automobile body, in the interest of providing a useful field of view to the driver, even when the main mirror is folded, as suggested by KANTO AUTO WORKS. One of ordinary skill would have recognized the rather obvious advantages attendant such a combination, such as in promoting safer operation of the vehicle and in preventing damage to the tires when parking.

With regard to claim 4, KANTO AUTO WORKS clearly suggest making the mirror on the base adjustable so as to allow drivers of various stature and seated posture to adjust the mirror for an optimum field of view.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tadashi, Sugimoto, and KANTO AUTO WORKS, and further in view of Komatsu (U.S. Patent number 5,594,585). As set forth above for claims 1 and 3, Tadashi, Sugimoto, and KANTO AUTO WORKS suggest the invention substantially as claimed. However, these references do not disclose a functional film to maintain perception and monitoring capability formed on the surface of the auxiliary mirror, as recited.

In the same field of endeavor, Komatsu disclose a mirror to be mounted on an automobile exterior. Komatsu teaches that when automobile exterior mirrors are used

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in the rain, raindrops collect on the surface of the mirror elements and cause viewing distortion that disrupts the perception and monitoring capability of the mirror. In order to overcome this difficulty and to provide safer vehicle operation through improved perception and monitoring capability, Komatsu suggests the inclusion of a functional film (hydrophilic film) on the viewing surfaces. The functional film causes the raindrops to flatten against the mirror element and thus reduces viewing distortion.

It would have been obvious to one of ordinary skill to include a functional film on the viewing surfaces in the mirror of Tadashi and Sugimoto, in the interest of reducing viewing distortion, and thus in the interest of promoting safer vehicle operation in the rain by maintaining the perception and monitoring capability with the film, as suggested by Komatsu.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tadashi, Sugimoto, and KANTO AUTO WORKS, and further in view of Vu, et al (U.S. Patent number 4,890,907; of record), or at least over Tadashi, Sugimoto, KANTO AUTOWORKS and Vu, et al, further in view of Hutzler (U.S. Patent number 6,811,288). As set forth above for claims 1 and 3, Tadashi, Sugimoto, and KANTO AUTO WORKS suggest the invention substantially as claimed. However, these references do not disclose the mirror base as including a light beam emitting device that illuminates areas aside from said automobile and areas in a range of a road viewed in the second auxiliary mirror.

In the same field of endeavor, Vu, et al disclose an outer mirror comprising an auxiliary mirror oriented obliquely downwardly and facing the rear of the automobile. Vu, et al teach that the auxiliary mirror provides a useful field of view to assist the driver during backing and parking maneuvers. In order to enhance the view during nighttime operation, Vu, et al suggest including a light emitting device in the auxiliary mirror assembly that illuminates areas aside from the automobile (areas to the side of - ), and areas in a range of a road viewed in the auxiliary mirror.

It would have been obvious to one of ordinary skill to provide a light emitting device in the second auxiliary mirror assembly of Tadashi, Sugimoto, and KANTO AUTO WORKS, in the interest of illuminating areas to the side of the automobile and areas of the road viewed in the auxiliary mirror, as suggested by Vu, et al. One of ordinary skill would have appreciated that such a combination would have promoted safer operation of the vehicle after dark.

It is believed that in adapting the teachings of Vu, et al to the mirror of Tadashi, Sugimoto, and KANTO AUTO WORKS, one of ordinary skill would have found it obvious to mount the light beam emitting device in the mirror base adjacent the second auxiliary mirror, since Vu, et al teach mounting the light beam emitter next to the mirror. However, if such is not the case, then, in the same field of endeavor, Hutzler discloses (Figs. 16 & 17) a mirror base (416) being attached on a side surface of an automobile body and extending sideward from said surface of said automobile body, and a mirror housing (414) having a separation distance from said side of said automobile body, suspended underneath said mirror base with a rotation capability to be reset into a

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housing position. Hutzel identifies the mirror base as a convenient location for inclusion of a light beam emitting device (behind lens 444). Barring any *unexpectedly* improved result arising from selection of the mirror base as the mounting locus for the light beam emitting device, it appears that such a selection would have been obvious to one of ordinary skill, since Vu, et al teach mounting the light source in the auxiliary mirror assembly next to the auxiliary mirror, and since Hutzel suggest the mirror base as a convenient location for mounting an auxiliary light source.

### ***Allowable Subject Matter***

Claims 5 – 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter:

The prior art, taken alone or in combination, fails to teach or fairly suggest *the combination* of first and second auxiliary mirrors arranged as recited, particularly wherein the *second* auxiliary mirror has a position marker thereon indicating a position of said automobile body, as recited in claims 5 – 9.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Herman (U.S. Patent number 6,015,215) discloses various mounting locations for an auxiliary rear view mirror.

Nagayama, et al (U.S. Patent number 5,226,034) discloses a vehicle mirror suspended from a mirror base mounted to an automobile side surface.

Easter (U.S. Patent number 5,500,773) disclose an outer mirror with a position marker integrated with the main viewing surface.

Polanyi, et al (U.S. Patent number 5,022,747) disclose an outer mirror with a feature integrated with the mirror for viewing a position marker.

ICHIKOH IND LTD (JP 2001-253298 A) disclose an outer, storable mirror arrangement located below a mirror base and having an auxiliary mirror oriented laterally and downwardly.

KARL KÄSSBOHRER FAHRZEUGWERKE GmbH (EP 0 396 930 A1) disclose an outer mirror movable between fully deployed and partially retracted positions and having an auxiliary mirror oriented laterally and downwardly.

MITTELHAEUSER (DE 3613556 A1) discloses a side view mirror with a light source for alignment of the mirror.

FORD MOTOR CO (GB 2,295,129 A) disclose a mounting location for an auxiliary mirror used with a side view mirror.

Miyahara Fumio (JP 05-229387 A) disclose position markers for use in combination with an outer mirror.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Juba whose telephone number is (571) 272-2314. The examiner can normally be reached on Mon.-Fri. 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Drew Dunn whose number is (571) 272-2312 and who can be reached on Mon.- Thu., 9 - 5.

The centralized fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for *all* communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2800.

  
**JOHN JUBA, JR.**  
**PRIMARY EXAMINER**  
Art Unit 2872

May 31, 2005